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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,761	01/26/2004	Michael Alan Siecke	44150/182	8779

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AMSTER, ROTHSTEIN & EBENSTEIN LLP  
90 PARK AVENUE  
NEW YORK, NY 10016

EXAMINER
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BUI, LUAN KIM

ART UNIT	PAPER NUMBER
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3728

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/30/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/764,761

Applicant(s)

SIECKE, MICHAEL ALAN

Examiner

Luan K. Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6,8-10 and 12-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22 and 23 is/are allowed.
- 6) ☒ Claim(s) 1-6,8-10,12-21,24,25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

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1. As a point of clarification, in claims 19-21, line 1, the phrase "The blank of" should be replaced with --The package of--.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 5, 6, 24 and 25 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Cetrelli (4,559,259) in view of Weber (2,634,046) and Kosterka (3,556,391). Cetrelli discloses a blank comprising an unfolded sheet of paper (Figure 1) defining a first face and a second face opposite the first face. The first face is flat and coated with a thermoplastic material (column 3, lines 54-57), the second face is unprinted and having at least one pair of adjacent parallel grooves (6). The blank is further comprising a foldline (8) extending along a horizontal midline (rotate the blank of Figure 1 in 90 degree) thereof transverse to the at least one pair of parallel grooves. Cetrelli also discloses the other limitations of the claims except for the first face being printed.

Weber teaches a blank comprising an unfolded sheet of cardboard/paperboard material defining a first face and a second face opposite the first face, the first face being flat, coated (a) and printed (column 1, line 11) and the second face being unprinted and defining at least one pair of adjacent parallel grooves (3, 5). Kosterka shows a blank (11) comprising an unfolded sheet (Figure 1)

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defining a first face and a second face with at least one of the faces is printed (column 2, lines 53-56) and a foldline (26) extending along a horizontal midline.

It would have been obvious to one having ordinary skill in the art in view of Weber and Kosterka to modify the blank of Cetrelli so the first face is also printed to provide more convenience for the user and because such printed information on the blank is old and conventional in the art.

With respect to the material of the blank of Cetrelli, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the blank of Cetrelli so it formed from paperboard in lieu of paper as taught by Weber since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

As to claims 1 and 24, see the blank of Cetrelli as modified above.

As to claim 25, the blank as shown in Figure 1 of Cetrelli as modified is considered equivalent to a paperboard component as claimed since the component as recited in the claim 25 is considered as one part of the blank that formed the package and a folded line (7) is considered equivalent to the folded line as claimed to form a concealed inner face that defined at least one groove (Figure 3).

4. Claim 3 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Kuchenbecker (4,740,163).

Cetrelli further fails to show the grooves being formed by laser. Kuchenbecker teaches a paperboard blank for forming a package comprising channels/grooves (25, 26) formed by laser.

It would have been obvious to one having ordinary skill in the art in view of Kuchenbecker to

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modify the grooves of Cetrelli so the grooves are formed by laser for better removing the material from the blank.

5. Claims 4 and 8-10 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Voss (5,427,309). Cetrelli further fails to show the second face being defined at least two spaced apart pairs of parallel grooves. Voss shows a blank (10) having at least two spaced apart pairs of parallel grooves (37-42) (Figure 8). It would have been obvious to one having ordinary skill in the art in view of Voss to modify the blank of Cetrelli as modified so the second face comprises at least two spaced apart pairs of parallel grooves to facilitate folding.

6. Claims 12, 13, 15-17 and 19-21 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Cetrelli (4,559,259) in view of Weber (2,634,046) and Matsuoka (6,761,307). Cetrelli discloses a package comprising a paper component (Figure 1) formed of blank folded along a horizontal midline (7) to define a double thickness with an exposed outer face thereof is coated, a concealed inner face thereof is unprinted and the concealed inner face defining at least one groove (6, Figure 3). Cetrelli also discloses the other claimed limitations except for the outer face being printed and the concealed inner face comprises at least one pair of adjacent parallel grooves.

Weber teaches a blank for forming a package comprising an unfolded sheet of cardboard/paperboard material defining an outer face and an inner face opposite the outer face, the outer face being flat, coated (a) and printed (column 1, line 11). Matsuoka teaches a package

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comprising a component (4b, 9a, Figures 1 & 3) formed of a blank folded along a fold line to form a concealed inner face defining at least one pair of adjacent parallel grooves.

It would have been obvious to one having ordinary skill in the art in view of Weber and Matsuoka to modify the package of Cetrelli so the outer face is also printed as taught by Weber to provide more convenience for the user and because such printed information on the blank is old and conventional in the art and the concealed inner face comprises at least one pair of adjacent parallel grooves as taught by Matsuoka to facilitate folding the blank of Cetrelli to form the package. With respect to the material of the blank of Cetrelli, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the blank of Cetrelli so it formed from paperboard in lieu of paper as taught by Weber since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

As to claims 15 and 19, it would have been obvious to one having ordinary skill in the art in view of the package of Cetrelli as modified so the concealed inner face comprises at least two or three spaced apart pair of parallel grooves since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

7. Claim 14 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 12 above, and further in view of Kuchenbecker (4,740,163). Cetrelli further fails to show the grooves being formed by laser. Kuchenbecker teaches a paperboard blank for forming a package comprising channels/grooves (25, 26) formed by laser.

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It would have been obvious to one having ordinary skill in the art in view of Kuchenbecker to modify the grooves of Cetrelli so the grooves are formed by laser for better removing the material from the blank.

8. Claim 18 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of The Official Notice. Cetrelli further fails to show the outer face comprises at least one plastic component. The Official Notice is taken of the old and conventional practice of providing a package comprising a plastic envelope/plastic component attached to an outer face of the package for holding information for mailing the package and such package is conventional used by the U.S. Postal Service. It would have been obvious to one having ordinary skill in the art in view of The Official Notice to modify the package of Cetrelli as modified so the outer face of the package includes a plastic envelope/plastic component for holding information. The plastic envelope/plastic component of Cetrelli as modified is capable to receive an recording medium.

### ***Response to Arguments***

Applicant's arguments filed on 12/18/2006 have been fully considered but they are not deemed to be persuasive.

Applicant's arguments with respect to Cetrelli on page 8 of the remarks are noted. They are not persuasive because Cetrelli discloses a container (abstract) formed from a blank (Figure 1) comprising a foldline (8) extending along a horizontal midline transverse to a pair of parallel

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grooves (6). To the extent that Cetrelli fails to show the foldline being extending along a horizontal midline, Kosterka shows a foldline (25, 26) extending along a horizontal midline.

Applicant further argues that "... they are not formed by removing material from the original blank as taught by the present invention" is noted. This is not understood because the claims are rejected not the invention.

In response to applicant's argument that there is no motivation to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, there does not appear to be anything unobvious about combining the references as indicated above to provide more convenient for the user.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after



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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is 571-272-4552. The examiner can normally be reached on 8:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. **The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for Formal papers and After Final communications.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lkb  
January 24, 2007



Luan K. Bui  
Primary Examiner  
Art Unit 3728